



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,247	10/29/2001	Chris A. Wolfe	010188	9072

23696 7590 12/08/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,247

Applicant(s)

WOLFE ET AL.

Examiner

Romain Jeanty

Art Unit

3623

WJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,41-45,47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 46, 49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This communication is in response to the amendment filed September 13, 2004. by the amendment, claims 1, and 4-5 have been amended. Claims 2-3 and 6-28 have been canceled. Claims 29-37 have been added.

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 29-37 been renumbered 41-49.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 4-5, 41-43, drawn to a method for arranging for the transporting freight 705, subclass 28.

Claims 44-45, drawn to an apparatus for arranging for the transportation of freight, classified in class 705 and subclass 28.

Claim 48, drawn to a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus for arranging for the transportation of freight, classified in 705, subclass

7.

II. Claims 46-47, drawn to a wireless communication device for arranging for the delivery of freight 705, subclass 7.

Claim 49, drawn to a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus for arranging for the transportation of freight, classified in 705, subclass 7.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as accepting and transmitting response for a request. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Newly submitted claims 46 and 49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 4-5, 41-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claims not recited within technological art.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of

"science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed

subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under 101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining

the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 1, 4-5, 41-44 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. Example: claim 1 recites method steps "receiving determining, transmitting, determining, and assigning .." can be broadly interpreted as being manually performed. Although the preamble recites the method as being computer implemented, no limitation supports this intended objective, i. e. none of the method steps recite computer implementation. Therefore, claim 1 is rendered outside the technological art and therefore is rendered non statutory under 35 U.S.C. §101 guidelines.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 4-5, 41, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) (Page 1, line 10 through page

Art Unit: 3623

3, line 30) in view of Helms et al (U.S. Patent No. 5,880,958) and further in view of Breen, Jr "Breen" (U.S. Patent No. 6,598,027).

As per claims 1, 5, and 41, Applicant's admitted prior art ((Page 2 line to page 3 line 21) discloses:

Providing a freight intended for transport by carrier having at least one carrier vehicle and a carrier control for communicating with the carrier vehicle, determining that the carrier is not available to transport the freight, providing a third party carrier having at least one third party vehicle and a third party control center for communicating with the third party vehicle, and determining that the freight can be transported by the third party vehicle of the third party carrier (Page 2 line to page 3 line 21).

Applicant's admitted prior art fails to explicitly teach the step of communicating freight transportation status from the third party to the carrier control center. Helms et al on the other hand, discloses a truck being available to make a delivery and the receiving of status information about a freight "loads" being transported (col. 10, lines 14-25). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of AAPA to include the receive loads status as evidenced by Hems et al. In so doing, would determine the locations of each tractor vehicle and freight load.

The combination of AAPA and Helm fails to explicitly disclose transmitting a request for a third party to transport the goods. Breen disclose the concept of requesting a third party to transport goods (col. 12, line 59 through col. 13 line 6). It would have been obvious to a person of ordinary skill in the art to modify AAPA and the disclosures of Helms to incorporate the teachings of Breen in order to handle delivery of the regulated goods to a buyer.

Claim 48 is a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform the steps of method of claim 1; therefore is analyzed similarly.

As per 4, Official Notice is taken that using mobile communication terminal and terrestrial-based wireless communication is notoriously well known in the communication art to receive and transmit information or messages effectively. It would have been obvious to a person having ordinary skill in the art to modify the disclosures of AAPA to include this well-known teaching with the motivation to efficiently transfer the messages.

Claim 44 is an apparatus for performing the steps of method claim 1; and is analyzed similarly.

12. Claims 42-43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Helms et al, in view of Breen as applied to claim 1 above and further in view of Malik (U.S. Patent No. 6,349,306).

As per claim 42-43, and 45, the combination of AAPA, Helms and Breen fails to explicitly disclose reconfiguring the network management facility for preventing subsequent communication between said third party and said carrier after the freight has been delivered. Malik on the other hand, discloses the concept of reconfiguring a network management (col. 2, lines 11-32). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of AAPA, Helm and Breen to incorporate reconfiguring the network management system of as taught by Malik in order to make such configuration management less time-consuming, expensive and error prone.

Art Unit: 3623

Response to Arguments

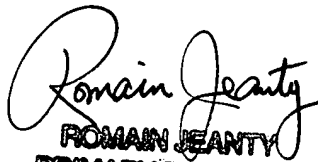
13. Applicant's arguments with respect to claim 1, 4, 41-49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Creasy et al (Wo0046728) discloses a processing information associated with a package to handled by a shipping service provider.

b. Hancock (U.S. Patent No. 6,785,718) disclose a method for interfacing with a shipping service.


ROMAIN JEANTY
PRIMARY EXAMINER
Art Unit 3623